

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the above amendments and in light of the following discussion, is respectfully requested.

Claims 12, 14, 23, and 25-28 are pending. In the present amendment, Claims 12 and 23 are currently amended, Claims 13, 17, and 24 are canceled without prejudice or disclaimer, and new Claims 27 and 28 are added. Support for the present amendment can be found in the original specification, for example, at page 7, lines 13-19, at page 11, lines 6-28, and in Claims 13, 17, and 24. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 12 and 23 were objected to; Claims 12, 14, 23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Schiminski et al. (U.S. Patent No. 4,431,138, hereinafter “Schiminski”) in view of Green (U.S. Patent No. 3,041,663), Schippers et al. (U.S. Patent No. 5,016,829, hereinafter “Schippers”), and Ideno et al. (U.S. Patent No. 4,511,095, hereinafter “Ideno”), and Sakurauchi et al. (Japanese Publication No. 06-329437, hereinafter “Sakurauchi”); and Claims 13, 17, and 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over Schiminski in view of Green, Schippers, Ideno, and Sakurauchi, and further in view of Westrich (U.S. Patent No. 6,105,896).

Initially, it is noted that Claim 12 is amended to clarify that the at least one positioning and guidance device is “configured to move the at least one thread with a primary stroke movement to position and guide the at least one thread on the spindles.” Thus, the primary stroke movement is the movement of the position and guidance device that moves the thread. As explained with respect to the non-limiting exemplary positioning and guidance device described in lines 5-16 on page 10 of the original specification, the primary stroke movement can be a rotation that moves the thread. Thus, the primary stroke movement is not necessarily linear.

In response to the objection to Claims 12 and 23, these claims are hereby amended as suggested on page 2 of the Office Action. It is respectfully submitted that no new matter is added. Thus, it is respectfully requested that the objection to Claims 12 and 23 be withdrawn.

Turning now to the rejections under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of these rejections and traverse these rejections, as discussed below.

The Office Action relies on references that were previously recited to reject the claims. Accordingly, the discussion of these references from the previous response are incorporated herein by reference and resubmitted. Further, Applicants again traverse the cited combinations since they would leave the modified device of Schiminski unsuitable for its intended purpose, as discussed below.

Schiminski is again cited as the primary reference. As can be seen in Figure 1 of Schiminski, the linear movement of the guiding device 3 extends along the whole length of the package of thread 8. Thus, it is not possible to add another linear movement to the thread 6 by moving the winding chuck 9.1 of Schiminski linearly since such movement would move the thread 6 outside of the package of thread 8. Accordingly, even in view of Green, a person of ordinary skill in the art would not find it obvious to continuously move the winding chuck 9.1 of Schiminski in a forward and reverse directions during winding.

Further, even if the winding chuck 9.1 of Schiminski were replaced with the tube 18 of Green, such a modified device cannot turn around a third axis with respect to the frame.

The Office Action further modifies the device of Schiminski to include the yarn lifting device 25 of Schippers. However, as can be seen in Figure 2, Schippers relies on two blades 7, 8 to move the thread into a certain position when it is returned from the yarn lifting device 25. As can be seen in Figure 1 of Schiminski, the guiding device 3 does not include blades and thus would not be able to accurately work with the yarn lifting device 25 of

Schippers. Thus, the combination of the yarn lifting device 25 of Schippers with Schiminski would not have a reasonable expectation of success.

Similarly, concerning Ideno, a straight ejector according to Ideno would require the ejector to be synchronized with the movement of the positioning device 3 of Schiminski, which would clearly be complex if not impossible to realize. Thus, the combination of the straight ejector of Ideno with Schiminski would not have a reasonable expectation of success.

Regarding Sakurauchi, the Office Action on page 11 notes that “[a]s the device of Sakaurachi is a computer, it is capable of being programmed to control anything.” Applicants respectfully traverse this assertion. In *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990), the Federal Circuit reversed the decision of the PTO Board which opined that it was sufficient if a prior art reference was merely “capable of” being operated according to the language of the claim at issue.

As discussed previously, the spindles in Sakurauchi do not move linearly during winding. There is no secondary stroke movement during winding, only for replacement. Thus, there is no evidence to suggest that the controller of Sakurauchi is adapted for controlling primary and secondary stroke movements.

Accordingly, in view of the above discussion, Applicants respectfully submit that the cited combinations do not disclose or suggest every feature recited in Claims 12 and 23. Thus, it is respectfully requested that the rejections of these claims, and all claims dependent thereon, be withdrawn.

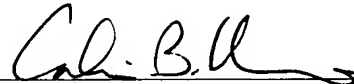
New Claims 27 and 28 are added by the present amendment. Support for new Claims 27 and 28 can be found in the original specification, for example in Figure 1b and the corresponding description. Thus, it is respectfully submitted that no new matter is added. Further, as Claims 27 and 28 depend on independent Claims 12 and 23, it is respectfully

submitted that Claims 27 and 28 patentably define over the cited references for at least the reasons discussed above with respect to Claims 12 and 23.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.



---

Philippe J.C. Signore, Ph.D.  
Attorney of Record  
Registration No. 43,922

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 07/09)

Colin B. Harris  
Registration No. 58,969